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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,056	11/29/2001	Shinji Aoyama	34169	7990
116	7590	08/24/2005	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			PEACHES, RANDY	
			ART UNIT	PAPER NUMBER
			2686	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/980,056	AOYAMA, SHINJI	
	Examiner	Art Unit	
	Randy Peaches	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20,22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/28/2005 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. ***Claims 1-20 and 22-23*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Metso et al (U.S. Patent Number 5,920,826) in view of Buhrmann et al. (U.S. Patent Number 5,903,845) in further view of Janky et al. (U.S. Patent Number 5,929,752).

Regarding ***claims 1, 6 and 11***, Metso et al discloses a mobile terminal (402), which reads on claimed "portable telephone", and a method of copying information, which reads on claimed "backing up data" and a portable computer (400), which reads on

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claimed "data backup equipment", where information stored in a said mobile terminal (402), said method comprising the steps of, as disclosed in column 7 lines 25-62, transmitting, information (data), which reads on claimed "data such as at least control information or setup function information required for operating", said portable telephone, telephone call information of telephone numbers, arrival telephone numbers, dispatch telephone numbers, call time and so on set and stored in said portable telephone (see column 7 lines 24-31) in association with a telephone call operation when a voice signal begins to be delivered and received for the telephone call between said portable telephone and personal computer (400), which reads on claimed "host office", see column 8 lines 21-30, via an interface cable and storing said data transmitted from said portable telephone in a said portable computer's (400) memory, which reads on claimed "data backup equipment", provided in or connected to said portable computer (400), whereby said data stored in said mobile terminal (402) are said copied.

However, Metso et al. does not disclosed where the transmitting means for the transfer of information from the said mobile terminal to the said portable computer is via a radio signal.

Buhrmann et al. teaches in column 3 lines 55-62, where the communication link used to transfer profile information may be via a wireless communication link, which reads on claimed "radio signal".

Therefore at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify Metso et al (U.S. Patent Number 5,920,826) to

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include Buhrmann et al. (U.S. Patent Number 5,903,845) in order to provide a method of copying information from a said mobile terminal to a said portable computer via a wireless communication link, for purposes of backing up the said information contained in the said mobile terminal.

However, the combination of Metso et al (U.S. Patent Number 5,920,826) and Buhrmann et al. (U.S. Patent Number 5,903,845) fails to clearly define automatically transmitting information of a mobile terminal to a said host office when a voice signal of a call begins to be transmitted and received at the said host office.

Janky et al. discloses in column 10 lines 26-52, wherein a cellular phone handset (83) receives or initiates an outgoing conversation, the conversation is detected and the data (conversation) is recorded in a memory unit (106) or remotely at an origination station (37)(see column 12 lines 48-56), which can be played back a later time.

Therefore at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the combined teachings of Metso et al (U.S. Patent Number 5,920,826) and Buhrmann et al. (U.S. Patent Number 5,903,845) to further include Janky et al. (U.S. Patent Number 5,929,752) in order to provide a method of copying information from a said mobile terminal to a said portable computer via a wireless communication link, for purposes of backing up the said information contained in the said mobile terminal and further being able to backup a conversation to a memory (106) or origination station (37) remotely for later retrieval.

Regarding **claims 2 and 20, 22-23**, as the combination of Metso et al (U.S. Patent

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Number 5,920,826), Buhrmann et al. (U.S. Patent Number 5,903,845) and Janky et al. (U.S. Patent Number 5,929,752) are made, the combination according to **claim 1**, wherein Metso et al further teaches in column 7 lines 24-62, where the method of copying information is characterized by automatically transmitting to said portable computer (400) the said data such as control information or setup function information required for operating said portable telephone, a telephone call information of telephone numbers, arrival telephone numbers, dispatch telephone numbers, call time and so on or other arbitrary data set and stored in said portable telephone. Buhrmann et al. further teaches in columns 3 and 8 lines 49-57 lines 59-67, respectively, of automatically transmitting said data, which reads on claimed "at an arbitrary time set by a timer".

Regarding **claims 3, 8 and 13**, as the combination of Metso et al (U.S. Patent Number 5,920,826), Buhrmann et al. (U.S. Patent Number 5,903,845) and Janky et al. (U.S. Patent Number 5,929,752) are made, the combination according to **claims (1 or 2), claim (6 or 7) and claims (10 through 12), respectively**, Metso et al further teaches where the said mobile terminal and method of copying information is characterized by further comprising the step of feeding back to said portable telephone said data stored in said data backup equipment provided in or connected to said host office whereby said data is re-memorized in said portable telephone. See Metso et al, column 7 lines 29-30.

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Regarding **claims 4, 9 and 14**, as the combination of Metso et al (U.S. Patent Number 5,920,826), Buhrmann et al. (U.S. Patent Number 5,903,845) and Janky et al. (U.S. Patent Number 5,929,752) are made, the combination according to **claim 3, claims (6 or 7), and claim 14**, respectively, Metso et al further teaches where the said mobile terminal method and said of copying information is characterized by further comprising the step of arbitrarily selecting and setting said data to be transmitted to said host office or said data to be fed back to said portable telephone from said data backup equipment provided in or connected to said host office. See column 9 lines 9-17 lines 28-35, respectfully.

Regarding **claims 5, 15, and 16-19**, as the combination of Metso et al (U.S. Patent Number 5,920,826), Buhrmann et al. (U.S. Patent Number 5,903,845) and Janky et al. (U.S. Patent Number 5,929,752) are made, the combination according to **claim 3, claims (11 or 12), claims (1 or 2), claim 4, claim 13 and claim 14, respectively**, Metso et al. does not disclosed where the transmitting means for the transfer of information from the said mobile terminal to the said portable computer is via a radio signal.

Buhrmann et al. further teaches in columns 3 and 8 lines 49-57 lines 59-67, respectively of a data backup method for a said mobile terminal (402) comprising the step of automatically processing or converting into other information said data transmitted from mobile terminal (402) to said data backup equipment provided in or connected to Personal Information Manager (PIM) or portable computer, which reads on

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claimed "said host office", in case that said data have such predetermined conditions as said data are required to be processed whereby said processed or converted data are fed back.

Therefore at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify Metso et al (U.S. Patent Number 5,920,826) to include Buhrmann et al. (U.S. Patent Number 5,903,845) in order to provide a method of copying information from a said mobile terminal to a said portable computer via a wireless communication link, for purposes of backing up the said information contained in the said mobile terminal.

Regarding **claim 6**, Metso et al discloses a mobile terminal (402), which reads on claimed "portable telephone", and a method of copying information, which reads on claimed "backing up data" and a portable computer (400), which reads on claimed "data backup equipment", where information stored in a said mobile terminal (402), said method comprising the steps of, as disclosed in column 7 lines 25-62, transmitting, information (data), which reads on claimed "data such as at least control information or setup function information required for operating", said portable telephone, telephone call information of telephone numbers, arrival telephone numbers, dispatch telephone numbers, call time and so on set and stored in said portable telephone (see column 7 lines 24-31) in association with a telephone call operation when a voice signal begins to be delivered and received for the telephone call between said portable telephone and personal computer (400), which reads on claimed "host office", see column 8 lines 21-

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30, via an interface cable and storing said data transmitted from said portable telephone in a said portable computer's (400) memory, which reads on claimed "data backup equipment", provided in or connected to said portable computer (400), whereby said data stored in said mobile terminal (402) are said copied.

However, Metso et al. does not disclosed where the transmitting means for the transfer of information from the said mobile terminal to the said portable computer is via a radio signal.

Buhrmann et al. teaches in column 3 lines 55-62, where the communication link used to transfer profile information may be via a wireless communication link, which reads on claimed "radio signal". Buhrmann et al. further teaches in columns 3 and 8 lines 49-57 lines 59-67, respectively of a mobile terminal, wherein said data transmitter (see FIGURE 1) section characterized by automatically transmitting to a said Personal Information Manager (PIM) or portable computer, which reads on claimed "said host office", said data or other arbitrary data set and stored in said portable telephone at an arbitrary time set by a timer.

Therefore at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify Metso et al (U.S. Patent Number 5,920,826) to include Buhrmann et al. (U.S. Patent Number 5,903,845) in order to provide a method of copying information from a said mobile terminal to a said portable computer via a wireless communication link, for purposes of backing up the said information contained in the said mobile terminal.

However, the combination of Metso et al (U.S. Patent Number 5,920,826) and Buhrmann et al. (U.S. Patent Number 5,903,845) fails to clearly define automatically transmitting information of a mobile terminal to a said host office when a voice signal of a call begins to be transmitted and received at the said host office.

Janky et al. discloses in column 10 lines 26-52, wherein a cellular phone handset (83) receives or initiates an outgoing conversation, the conversation is detected and the data (conversation) is recorded in a memory unit (106) or remotely at an origination station (37)(see column 12 lines 48-56), which can be played back a later time.

Therefore at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the combined teachings of Metso et al (U.S. Patent Number 5,920,826) and Buhrmann et al. (U.S. Patent Number 5,903,845) to further include Janky et al. (U.S. Patent Number 5,929,752) in order to provide a method of copying information from a said mobile terminal to a said portable computer via a wireless communication link, for purposes of backing up the said information contained in the said mobile terminal and further being able to backup a conversation to a memory (106) or origination station (37) remotely for later retrieval.

Regarding **claim 10**, as the combination of Metso et al (U.S. Patent Number 5,920,826) and Buhrmann et al. (U.S. Patent Number 5,903,845) are made, Metso et al discloses a portable computer (400), which reads on claimed "data backup equipment" for backing up data stored in a mobile terminal (402), which reads on claimed "portable telephone",

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such as a cellular phone, a personal handy phone, a car telephone, a maritime mobile radiotelephone, a satellite cellular phone machine or the like.

However, Metso et al. does not disclosed where the transmitting means for the transfer of information from the said mobile terminal to the said portable computer is via a radio signal.

Buhrmann et al. teaches in column 3 lines 55-62, where the communication link used to transfer profile information may be via a wireless communication link, which reads on claimed "radio signal". Buhrmann et al. further teaches in columns 3 and 8 lines 49-57 lines 59-67, respectively of a mobile terminal, wherein said data transmitter (see FIGURE 1) section characterized by automatically transmitting to a said Personal Information Manager (PIM) or portable computer, which reads on claimed "said host office", said data or other arbitrary data set and stored in said portable telephone at an arbitrary time set by a timer. Buhrmann et al. further teaches in columns 3 and 8 lines 49-57 lines 59-67, respectively, by automatically notifying said mobile terminal (402) at an arbitrary time set by a timer that data such as control information or setup function information required for operating said portable telephone, a telephone call information of telephone numbers, arrival telephone numbers, dispatch telephone numbers, call time and so on set and stored in said mobile terminal should be transmitted to a said portable computer or PIM.

Therefore at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify Metso et al (U.S. Patent Number 5,920,826) to include Buhrmann et al. (U.S. Patent Number 5,903,845) in order to provide a method

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of copying information from a said mobile terminal to a said portable computer via a wireless communication link, for purposes of backing up the said information contained in the said mobile terminal.

However, the combination of Metso et al (U.S. Patent Number 5,920,826) and Buhrmann et al. (U.S. Patent Number 5,903,845) fails to clearly define automatically transmitting information of a mobile terminal to a said host office when a voice signal of a call begins to be transmitted and received at the said host office.

Janky et al. discloses in column 10 lines 26-52, wherein a cellular phone handset (83) receives or initiates an outgoing conversation, the conversation is detected and the data (conversation) is recorded in a memory unit (106) or remotely at an origination station (37)(see column 12 lines 48-56), which can be played back a later time.

Therefore at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the combined teachings of Metso et al (U.S. Patent Number 5,920,826) and Buhrmann et al. (U.S. Patent Number 5,903,845) to further include Janky et al. (U.S. Patent Number 5,929,752) in order to provide a method of copying information from a said mobile terminal to a said portable computer via a wireless communication link, for purposes of backing up the said information contained in the said mobile terminal and further being able to backup a conversation to a memory (106) or origination station (37) remotely for later retrieval.

Regarding **claim 12**, as the combination of Metso et al (U.S. Patent Number 5,920,826), Buhrmann et al. (U.S. Patent Number 5,903,845) and Janky et al. (U.S. Patent Number

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5,929,752) are made, the combination according to **claim 11**, the combination of Metso et al (U.S. Patent Number 5,920,826) and Janky et al. (U.S. Patent Number 5,929,752) fails to clearly disclose wherein the data read section automatically reads information required for operating said portable telephone, a telephone call information of telephone numbers, arrival telephone numbers, dispatch telephone numbers, call time and so on or other arbitrary data set.

Buhrmann et al. teaches of a Personal Information Manager (PIM) wherein, as taught in columns 3 and 8 lines 49-57 lines 59-67, respectively, automatically reads said data such as control information or setup function information required for operating said portable telephone, a telephone call information of telephone numbers, arrival telephone numbers, dispatch telephone numbers, call time and so on or other arbitrary data set and stored in said portable telephone at an arbitrary time set by a timer.

Therefore at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the combined teachings of Metso et al (U.S. Patent Number 5,920,826) and Janky et al. (U.S. Patent Number 5,929,752) to further include Buhrmann et al. (U.S. Patent Number 5,903,845) in order to provide a method of copying information from a said mobile terminal to a said portable computer via a wireless communication link, for purposes of backing up the said information contained in the said mobile terminal and further being able to backup a conversation to a memory (106) or origination station (37) remotely for later retrieval.

Response to Arguments

Applicant's arguments with respect to ***claims 1-20 and 22-23*** have been considered but are moot in view of the new ground(s) of rejection.

Regarding ***claim 1***, the Applicant asserts that the combination of the cited prior art by the Examiner fails to clearly disclose each limitation taught by the Applicant. The Examiner would like to bring to the Applicant's attention wherein the method of the examination performed to provide the broadest, most reasonable interpretation cited against the Applicant's claimed language. According to claim 1, there are three distinct primary limitations that the Examiner will address:

- a.) Backing up data to a remote location (host office)
- b.) Data being selected from a group consisting of control information and setup function information
- c.) initiating a backup process when a voice signal is delivered and received for a telephone call between the said portable telephone and the said host office

The Examiner would like to thoroughly explain his reasoning against each of the primary limitations.

1.) A method for backing up data stored in a portable telephone that cooperates with a host office for telephone communication,

- Metso et al discloses a mobile terminal (402), which reads on claimed "portable telephone", and a method of copying information, which reads on claimed

"backing up data" to a portable computer (400). The portable computer is deemed to be a *"host office for telephone communication"* due to the fact that, as disclosed in column 7 lines 29-40, SMS messages are sent to the said device for storage; wherein SMS messaging is a type of telephone communication.

2.) *Data being selected from a group consisting of control information and setup function information*

- Metso et al. continues to disclose wherein information (data) is sent to the said personal computer. The information is considered to be "set-up" information due to the fact that it is information pertaining to a phone number. The phone number is used to set-up a call. In addition, but not mentioned, Janky teaches of recording a contact phone number which is received from the caller's phone. Again, the language presented is interpreted by the Examiner as set-up information.

3.) *Initiating a backup process when a voice signal is delivered and received for a telephone call between the said portable telephone and the said host office.*

- The Examiner cited Janky to bring to light the facts as discloses in column 10 lines 26-52, wherein a cellular phone handset (83) receives or initiates, which reads on claimed "delivered," an outgoing conversation, the conversation is detected and the data (conversation), see column 10 lines 37-40, is recorded in a memory unit (106) or remotely at an origination station (37)(see column 12 lines 48-56), which can be played back a later time. The Examiner, based on the

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claimed language, concludes that the process by which Janky asserts, clearly parallels with the Applicant's function.

Therefore based on the above office action and the response of the arguments, **claims 1-20, 22-23** stands rejected.

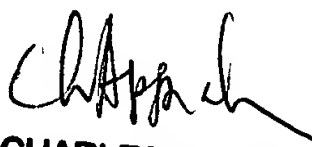
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (571) 272-7914. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Randy Peaches
August 21, 2005


CHARLES APPIAH
PRIMARY EXAMINER